

Serial No.: 08/450,437
Group Art Unit No.: 1207

pharmaceutical composition, classified in Class 514, subclass 331; Group II, covering claims 12 and 13, drawn to a method for making a pharmaceutical, classified in Class 546, subclass 1; and Group III, covering claims 15 and 16, drawn to a method of treatment, classified in Class 514, subclass 331. The Action indicates that the claims of Groups I and III will be examined together, therefore, rendering moot a discussion of their independence and distinctness. In addition, Applicants are required to elect a single disclosed species for prosecution on the merits. Applicants respectfully traverse the requirements for restriction and election and request reconsideration.

It is urged that the above Groups are merely different embodiments of a single inventive concept for which a single patent should issue and do not constitute distinct inventions such as to require that the subject matter be prosecuted in separate patent applications. The inventions of Groups I and III and Group II are clearly related, the compounds having arisen from a singular research effort and having a common utility. Furthermore, since the compounds have a core nucleus of structure there is not an undue burden on the Examiner with respect to searching the subject matter of the invention.

Therefore, it is believed that an adequate search with respect to the compound, composition, and method of use claims (Groups I and III), would necessarily encompass the same art as a search for a process of making such compounds (Group II). Indeed, the PTO would not allow a patent to issue on compounds if the processes for making and using the claimed compounds were not disclosed in the same application.

In addition, the Examiner's attention is invited to M.P.E.P. §808 which states that the reasons for insisting upon restriction or election must be given. Typically, the reason for insisting upon restriction is that there would be some extra burden on the PTO to examine the allegedly separate inventions in a single patent application. Applicants emphasize that the classification system was implemented to facilitate searching and not to serve as a basis for requiring an applicant to dismember his application. In and of itself, the classification system is no basis for requiring restriction, and can lend no weight to the position set forth in the Official Action.

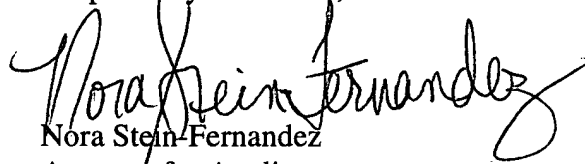
Accordingly, in view of the foregoing and further in view of the interest of efficiency and cost savings to both Applicants and the PTO, reconsideration and withdrawal of the requirement for restriction are requested. However, pursuant to 37 C.F.R. §§1.142 and 1.143, Applicants provisionally elect, subject to the traverse set forth above, Group I, covering claims 1-11 and 14, with the understanding that at least Group III will be searched along with a search of Group I. Applicants elect as a species for further prosecution, (-)-(S)-N-(α -ethylbenzyl)-3-hydroxy-2-phenylquinoline-4-carboxamide, i.e., a compound of formula (I) wherein X is

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oxygen; Ar is phenyl; R is ethyl; R₁ is hydrogen; R₂ is hydrogen; R₃ is hydrogen; R₄ is hydroxyl; and R₅ is phenyl (Example 85). Applicants hereby reserve the right to file one or more divisional applications directed to the non-elected subject matter.

Based upon the above discussion, withdrawal of the requirement for restriction, favorable consideration of claims 1-16 and allowance of this application with claims 1-16 are earnestly solicited.

Respectfully submitted,



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